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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/600,379 | 06/20/2003 | Steve B. Taylor | 2236.001 | 7549 |
| 7590 | 08/23/2005 | | EXAMINER | |
| Ray R. Regan, Esq. Law Office of Ray R. Regan, P.A. P.O. Box 1442 Corrales, NM 87048 | | | MACARTHUR, VICTOR L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3679 | |

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------|------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/600,379 | TAYLOR, STEVE B. | |
| | Examiner | Art Unit | |
| | Victor MacArthur | 3679 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 June 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 21 June 2005 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Proper Amendment Format Under 37 CFR 1.121

The examiner notes that the amendment filed on 6/21/2005 improperly lists the status of claims 23-31 as being "Withdrawn". Note that claims 23-31 were canceled in the amendment filed on 7/9/2004. For purposes of the current Office Action, the examiner has assumed claims 23-31 to be canceled. The applicant must correctly list the status of the claims in the future to avoid a holding of Non-Compliance.

Drawings

The Drawings are objected to as follows:

- Figure 3 of the drawings is objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "40" has been used twice to designate two separate elements.
- Figure 3 of the drawings is objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "36" and "40" have both been used to designate the same element.
- Figure 4 of the drawings is objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "50" and "48" have both been used to designate the same element.
- Figure 4 of the drawings is objected to as failing to comply with 37 CFR 1.84(p)(5) because it does not include reference sign (52) as mentioned in the description (p.7, l.27).

- Figure 5 of the drawings is objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "68" has been used twice to designate two separate elements.
- Figure 8A of the drawings is objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "68" and "10" have both been used to designate the same element.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Means plus Function

The applicant has not met the burden for showing non-equivalence of the prior art applied with regard to the limitation "Means for mounting" (line 4 of claim 1 and elsewhere). The limitation is described in the disclosure so broad so as to encompass any and all structure, material or acts for performing the claimed function (i.e. "mounting") as follows:

- Two different structural **EXAMPLES** for the "means for mounting" are given: one in which the means is a plurality of bores 24a-d (amendment to spec. filed 6/21/2005,

ll.5-25); and another example in which ball washer assemblies are used (spec. p.4, ll.1-2) as the “means for mounting” (emphasis added).

- The Specification clearly states (p.4, l.28 – p.5, l.9) that the embodiment examples described in the Specification are not meant to be limiting to the claims.
- The Specification clearly states (p.9, ll.17-25) that the drawing figures 1-13 show only one of the many possible embodiments of the invention such that they are not limiting of the claims.

As such, the applicant’s disclosure fails to set forth any clear scope for the limitation “means for mounting” that is any narrower than the recited term itself. Accordingly, the examiner must read the term broadly enough to encompass any structure capable of mounting as an equivalent. Reading any “merely exemplary” structure into the claims from the applicant’s specification or drawings would be contrary to public policy of granting patents which provide adequate notice to the public as to a claim’s true scope. See MPEP §2184.

Specification

The amendment filed 6/21/2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is the statement in lines 6-7 of page 3 of the Specification amendment (replacing page 7 of the original Specification), which states that “mounting means 36... is a plurality of bores 24a-d”. While the application as originally filed did support the

existence of a plurality of embodiments of the mounting means, no specific embodiment of the “mounting means” as being the “bores” was recited.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 11 is rejected under 35 U.S.C. 112, first paragraph, because the specification (**AS ORIGINALLY FILED, SEE OBJECTION TO SPECIFICATION ABOVE**), while being enabling for mounting means including one or more ball washers assemblies (Specification, p.4, ll. 1-2 and p. 7, ll.8-9), does not reasonably provide enablement for “a plurality of ball washer assemblies combinable with the mounting means” (line 4 of claim 11). The specification (**AS ORIGINALLY FILED, SEE OBJECTION TO SPECIFICATION ABOVE**) does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. The problem posed by claim 11 is that it requires a plurality of ball washer assemblies that are not the means for mounting (as provided for in the Specification) but rather are combinable with the means for mounting. The Examiner notes that a means for mounting that consists of a plurality of ball washers is only one preferred embodiment (p.7, ll.8-9) such that an equivalent means for mounting that is not one or more ball washers can be used. However the specification does not

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adequately describe any such equivalent means for mounting much less describe how a plurality of ball washers could be combined with such an equivalent means for mounting.

Claim Rejections - 35 USC § 102

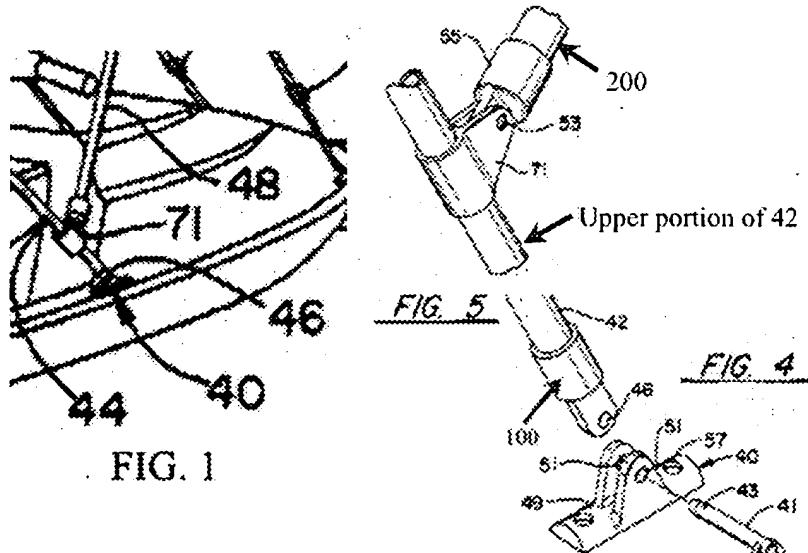
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Murray U.S.

Patent 5697320 (see marked-up figures below).



Claim 1. Murray discloses (figs.1, 4, 5) a variably positionable coupler mountable on a curved surface, comprising: a base (40) formed with an upper side and a lower side, wherein the lower side is a substantially flat planar surface; means (57) for mounting the base on the curved surface (curved surface of the watercraft as seen in figure 1); a tub (100) adjustably connectable

to the base; a plug [42 (including upper portion of 42) and 71] repositionably attachable to the tub; a neck (55) rotatably insertable in the plug [42 (including upper portion of 42) and 71], wherein the neck is formed for securing a shaft (200) to the neck; and a clevis mechanism (clevis connection between 55 and 71) slidably and demountably engageable with the plug and the neck. (Note that while the Murray curved surface does not curve at its point of contact with element 40, it does curve elsewhere and is thus a curved surface within the broadest reasonable interpretation of the claim language).

Claim 2: Murray discloses opposing yokes (tab portions of 40 receiving 41) monolithically extending at substantially right angles from the upper side of the base.

Claim 3. Murray discloses one or more bores (51) formed in the base with a proximal end and a distal end, and further wherein the one or more bores are shaped for removable engagement with a bolt (41). The word "bolt" is taken by the Examiner to mean, "a metal rod or pin for fastening objects together" in accordance with Merriam-Webster's Collegiate Dictionary Tenth Edition.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murray U.S. Patent 5697320 (see marked-up figures above) in view of Landgrebe U.S. Patent 5704749.

Claim 4. Murray does not disclose a frustoconical recess. Landgrebe teaches (fig. 1 and cols.3-4) a frustoconical recess (35, 55) formed adjacent the proximal end of one or more bores (portion of B receiving A), which is beneficial for improving the alignment of a fastener within a bore during assembly (col.4, ll.1-20). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the coupler of Murray to include, frustoconical recesses, as taught by Landgrebe, for the purpose of improving fastener alignment during assembly.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murray U.S. Patent 5697320 (see marked-up figures above) in view of Landgrebe U.S. Patent 5704749, as applied to claim 4 above, and further in view of Schroeder U.S. Patent 1257536.

Claim 5. Murray discloses that the means for mounting comprises a plurality of holes but does not specify what type of fasteners and washers are used. Murray further suggests (col.2, ll.61-65) adaptation for use on land vehicles but does not detail such adaptation. Schroeder teaches (figs. 1 and 2) a means for mounting that includes a ball washer assembly received in a concave cup (portion of 4 receiving 8) formed adjacent a distal end of one or more bores (hole portion of 4 receiving 10). Schroeder states (p.2, ll.55-95) that ball washer means for mounting are beneficial for mounting components in the variety of positions found on land vehicles (automobiles). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to adapt the Murray means for mounting to a land vehicle, as suggested by Murray, by including ball washers to be used at each hole of the Murray means for

mounting, as taught by Schroeder, for the purpose mounting components in the variety of positions found on land vehicles (automobiles).

Claims 6-13 and 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murray U.S. Patent 5697320 (see marked-up figures above) in view of Schroeder U.S. Patent 1257536.

Claim 6. Murray discloses that the means for mounting comprises a plurality of holes but does not specify what type of fasteners and washers are used. Murray further suggests (col.2, ll.61-65) adaptation for use on land vehicles but does not detail such adaptation. Schroeder teaches (figs.1 and 2) a means for mounting that includes a ball washer assembly received in a concave cup (portion of 4 receiving 8) formed adjacent a distal end of one or more bores (hole portion of 4 receiving 10). Schroeder states (p.2, ll.55-95) that ball washer means for mounting are beneficial for mounting components in the variety of positions found on land vehicles (automobiles). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to adapt the Murray means for mounting to a land vehicle, as suggested by Murray, by including ball washers to be used at each hole of the Murray means for mounting, as taught by Schroeder, for the purpose mounting components in the variety of positions found on land vehicles (automobiles).

Claim 7. Murray as modified by Schroeder suggests that the plurality (Murray) of ball washer (Schroeder) assemblies includes a second threaded bolt (Schroeder, 10) formed with a first diameter.

Claim 8. Murray as modified by Schroeder suggests that the plurality of ball washer assemblies includes a ball washer (Schroeder, 8).

Claim 9. Schroeder teaches that the ball washer is formed with a substantially hemispherical exterior surface (top of 8), an interior surface (bottom of 8), and a duct (hole within 8) between the substantially hemispherical exterior surface and the interior surface formed with a second diameter larger than the first diameter of the second threaded bolt.

Claim 10. Schroeder teaches a nut assembly (15).

Claim 11. Murray discloses a coupler system, comprising: a base (40) formed with opposing yokes (yoke portions of 40 receiving 41); means (57) formed in the base for mounting the base on a curved surface; a boom-swivel device (42, 71, 55) detachably fixable to the base for securing a shaft (200) to the coupler system. Murray discloses that the means for mounting comprises a plurality of holes but does not specify what type of fasteners and washers are used. Murray further suggests (col.2, ll.61-65) adaptation for use on land vehicles but does not detail such adaptation. Schroeder teaches (figs.1 and 2) a means for mounting that includes a ball washer assembly received in a concave cup (portion of 4 receiving 8) formed adjacent a distal end of one or more bores (hole portion of 4 receiving 10). Schroeder states (p.2, ll.55-95) that ball washer means for mounting are beneficial for mounting components in the variety of positions found on land vehicles (automobiles). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to adapt the Murray means for mounting to a land vehicle, as suggested by Murray, by including ball washers to be used at each hole of the Murray means for mounting, as taught by Schroeder, for the purpose mounting components in the variety of positions found on land vehicles (automobiles).

Claim 12. Murray discloses that the opposing yokes are formed with opposing apertures (51).

Claim 13. Murray discloses that the mounting means includes a bore (57) formed in the base.

Claim 16. Murray as modified by Schroeder suggests that the plurality (Murray) of ball washer (Schroeder) assemblies includes a bolt (Schroeder, 10) formed with a first diameter.

Claim 17. Murray as modified by Schroeder suggests that the plurality of ball washer assemblies includes a ball washer (Schroeder, 8) formed with a duct (9) having a second diameter larger than the first diameter of the bolt.

Claim 18. Murray as modified by Schroeder suggests that the plurality of ball washer assemblies includes a nut assembly (15).

Claim 19. Murray discloses that the boom-swivel device includes at least one tub (100) adjustably connectable to the opposing yokes.

Claim 20. Murray discloses that the boom-swivel device includes a plug (42, 71) repositionably attachable to the tub.

Claim 21. Murray discloses that the boom-swivel device includes a neck (55) for supporting a shaft (200) rotatably insertable in the plug.

Claim 22. Murray discloses that the boom-swivel device includes a clevis mechanism (clevis between 55 and 71) engageable with the plug and the neck.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murray U.S. Patent 5697320 (see marked-up figures above) in view of Schroeder U.S. Patent 1257536, as applied to claim 13 above, and further in view of Landgrebe U.S. Patent 5704749.

Claim 14. Murray does not disclose a recess. Landgrebe teaches (fig.1 and cols.3-4) a recess (55) formed in one end of a bore (portion of B receiving A), which is beneficial for improving the alignment of a fastener within a bore during assembly (col.4, ll.1-20). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the coupler of Murray to include, a recess, as taught by Landgrebe, for the purpose of improving fastener alignment during assembly.

Claim 15. Schroeder teaches a mounting means that includes a cup (portion of 4 receiving 8) formed in the other end of a bore (5) for supporting the ball washer.

Response to Arguments

Applicant's arguments filed on 6/21/2005 with regard to the claim rejections have been fully considered but they are not persuasive.

The Applicant argues that the Murray coupler is not variably positionable since it does not conform to the applicant's specification (p.2, ll.8-26) and drawings. This is not persuasive. The Murray coupler is "variably positionable" in that it is capable of being positioned in a variety of configurations and positions. The recited passage of the specification does not set forth any special definition for the limitation "variably positionable" but rather recites exemplary uses for the applicant's variably positionable coupler. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In*

re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear and deliberate definition in the specification. Exemplification is not an “explicit definition” and even “explicit definitions” can be subject to varying interpretations. *In re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *Teleflex Inc. v. Ficosa North America Corp.*, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002), *Rexnord Corp. v. Laitram Corp.*, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001), and MPEP 2111.01.

The applicant argues that the Murray elements, as referred to by the examiner in the marked-up drawings above, do not read upon that applicant’s claims because the elements of figure 4 and figure 5 do not form a connected assembly. This is not persuasive. Note that Figure 5 is a close-up depiction of an area of figure 1 near element 71. Further note that Figure 4 is a close-up depiction of an area of figure 1 near element 40. As clearly shown in figure 1, the element 71 area is directly above and connected to the element 40 area. Thus, the elements of figure 5 are directly above and connected to the elements of figure 4.

The applicant argues that the Murray coupler is not “mountable on a curved surface”. This is not persuasive as follows:

- The Murray coupler is “Mountable on a curved surface” in that it presents structure (40) that is capable of being so mounted by any of various means (e.g. holes 57, bolts, glue, mere placement, straps, etc.).

- Even if the claims were amended to positively recite --mounted on a curved surface-- the Murray watercraft surface as seen in Murray's figure 1 is curved in as much as the Applicant's watercraft surface as seen in Applicant's figure 14 is curved.
- Mere mounting on a curved surface does not require perfect conformity therewith. Such that the question of whether the applicant's coupler is more stable on a curved surface than that of the prior art is irrelevant, since no specific limitation regarding degree of stability is positively recited in the claims. What is relevant is whether the prior art is mountable in some manner, which it clearly is.

The applicant argues that the prior art plug of Murray is not one piece as the applicant's plug is, as shown in the applicant's drawings. This is not persuasive, since the applicant's claims do not recite one-piece construction. The applicant further argues that there is no requirement for one-piece construction to be claimed. This too is unpersuasive. While there is no requirement for the applicant to claim one-piece construction, there is a requirement for the applicant to clearly set forth what aspects of the invention protection is being sought. Therefore, the limitation "tub", as currently recited in the claims is broad enough to include both one-piece and multi-piece tubs. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims, including one-piece homogenous construction. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The applicant argues that there is no motivation to make the rejection of claim 4. This is not persuasive. Motivation for the obviousness rejection of claim 4 comes from Landgrebe who

teaches (fig.1 and col.4, ll.1-20) desirability for improving the alignment of a fastener within a bore during assembly as motivation.

The applicant argues that there is no motivation to make the obviousness rejection of claim 5. This is not persuasive. Motivation for said rejection comes from Schroeder who states (p.2, ll.55-95) that ball washer means for mounting are beneficial for mounting components in the variety of positions found on land vehicles (automobiles).

The applicant argues that there is no motivation to make the obviousness rejection of claim 11. This is not persuasive. Motivation for said rejection comes from Schroeder who states (p.2, ll.55-95) that ball washer means for mounting are beneficial for mounting components in the variety of positions found on land vehicles (automobiles).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

VLM
VLM
August 18, 2005

Daniel P Stodola

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